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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		RD28742/SWA (GERD:0128)	
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		10/065,848	11/25/2002
		First Named Inventor Evangelos Laskaris	
		Art Unit	Examiner
		2859	Fetzner, Tiffany
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u>Tait R. Swanson</u> Signature	
<input type="checkbox"/> applicant/inventor.		Tait R. Swanson	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. 48,226		(281) 970-4545	
Registration number		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		December 21, 2006	
Registration number if acting under 37 CFR 1.34		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Evangelos Laskaris et al.

Serial No.: 10/065,848

Filed: November 25, 2002

For: COLD MASS SUPPORT
STRUCTURE AND HELIUM
VESSEL OF ACTIVELY
SHIELDED HIGH FIELD OPEN
MRI MAGNETS


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Group Art Unit: 2859

Examiner: Tiffany A. Fetzner

Atty. Docket: RD28742-1/SWA
GERD:0128

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December 21, 2006	
Date	Tait R. Swanson

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action mailed September 21, 2006, Appellants respectfully submit this Pre-Appeal Brief Request for Review. This Request is being filed concurrently with a Notice of Appeal.

In the Final Office Action, the Examiner rejected claims 1-38 under 35 U.S.C. § 102 as unpatentable over either Lvovsky et al. (U.S. Patent No. 6,570,475) or Kinanen (U.S. Patent No. 6,335,670). Specifically, the Examiner rejected independent claim 1 as anticipated by Lvovsky, and rejected claims 1-38 as anticipated by Kinanen. The Appellants, however, respectfully submit that these rejections are clearly improper in view of several clear legal and factual deficiencies in the Examiner's rejections.

During several telephonic interviews in June 2006, the Appellants' representative (Tait R. Swanson) discussed various amendments with the Examiner to expedite allowance of the present application, and eventually reached an agreement as set forth in the Amendment and Interview

Summary filed on June 22, 2006. During these discussions, the Appellants' representative and the Examiner agreed that the Lvovsky reference does not disclose a main coil, ferrous ring, and shielding coil disposed one after another in an outward direction from the imaging volume. In other words, the Lvovsky reference does not disclose a ferrous ring disposed between a main coil and a shielding coil. It was the Appellants understanding that all pending claims 1-38 were allowable over the Lvovsky reference based on the lengthy discussions and amendments resulting from such discussions. However, once again, the Examiner has presented another rejection based on this same Lvovsky reference as well as another reference. Appellants submit that these rejections are clearly unsupported for at least the reasons set forth below.

Deficiencies of Lvovsky reference

Independent claim 1 recites an "open magnetic resonance imaging (MRI) device, comprising: a main coil configured to generate a magnetic field to image a volume, wherein the main coil comprises a first axis, a first radius, and a first axial distance from the volume; a plurality of shaping coils comprising second axes, second radii, and second axial distances from the volume, wherein the second radii are smaller than the first radius of the main coil, and wherein the second axial distances are greater than or equal to the first axial distance of the main coil to shape the magnetic field in the volume; a substantially cylindrical support comprising a third axis and a third radius, wherein the first, second, and third axes are generally aligned with one another, wherein the substantially cylindrical support is disposed radially between the main coil and the plurality of shaping coils; and a pressure vessel disposed about the main coil, the plurality of shaping coils, and the substantially cylindrical support."

In the Final Office Action, the asserted that "the claims as set forth do not structurally distinguish over the applied art because the applicant uses only "axially" or "radially" to define the frame of reference for the individual components. There is not enough specific component relationships to distinguish the applicants structure of the instant application, from that of the prior art, since axially and "radially" can be referenced from any axis, up down, right left, horizontal, vertical, etc." Final Office Action, page 14. The Appellants respectfully disagree with the Examiner's interpretation of the claims, because the Examiner appears to be reading

specific claim terms out of context of the claim as a whole and without giving a reasonable interpretation to those specific claim terms.

The Appellants stress that the pending claims must be given an interpretation that is reasonable and consistent with the specification. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969) (emphasis added); see also *In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); see also M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is “the primary basis for construing the claims.” See *Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. See *id.*

In addition, interpretation of the claims must also be consistent with the interpretation that one of ordinary skill in the art would reach. See *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. “The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation.” See *Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on “usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art.” See *id.*

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

With regard to claim 1, the Appellants stress that the claim as a whole recites axes and radii of the various components, such that the terms “axially” and “radially” do in fact have a clear reference that is different that the cited art. One of ordinary skill in the art would not

interpret these claim terms, particularly in view of the claim as a whole, to mean any possible directions or orientations as suggested by the Examiner. The Lvovsky reference clearly fails to teach or suggest, among other things, “the substantially cylindrical support is disposed radially between the main coil and the plurality of shaping coils; and a pressure vessel disposed about the main coil, the plurality of shaping coils, and the substantially cylindrical support,” as recited by claim 1.

Deficiencies of Kinanen reference

With regard to independent claims 1, 17, 20, 23, 33, and 36, the Appellants stress that Kinanen reference is also missing the same features as the Lvovsky reference, among other things. Specifically, the Examiner suggested that the component 36 is the cylindrical support recited in the present claims. See Final Office Action, page 3. However, the Kinanen reference clearly discloses that lip 36 is part of an overhead (or circular upper) ferrous support 18, which is not radially between any of the coils. See Kinanen, FIG. 1; abstract; col. 2, line 61 – col. 3, line 3. Instead, the lip 36 only slightly protrudes from the overhead support 18, but is clearly too thick to be radially between the various coils. Again, the overhead support 18 is clearly intended to be overhead rather than between any of the coils, and there is clearly no reason for one of ordinary skill in the art to interpret this lip 36 to be a cylindrical support radially between the coils as recited in the present claims, e.g., independent claims 1, 23, and 33.

Again, independent claim 1 recites “the substantially cylindrical support is disposed radially between the main coil and the plurality of shaping coils.” Similarly, independent claim 23 recites “the first cylindrical portion is disposed radially between the first main coil and the first set of shaping coils, and the second cylindrical portion is disposed radially between the second main coil and the second set of shaping coils.” Finally, independent claim 33 recites “opposite shaping coils are disposed concentrically within the opposite cylindrical supports” and “opposite main coils are disposed concentrically about the opposite cylindrical supports.” In addition, claim 33 recites “opposite ferromagnetic rings” and “opposite shielding coils” are “disposed concentrically about the opposite cylindrical supports.” Clearly, Kinanen fails to teach or suggest these arrangements as recited by independent claims 1, 23, and 33. In view of this

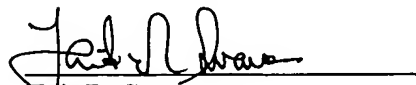
deficiency, among others, the Kinanen reference cannot support a *prima facie* case of anticipation of these independent claims 1, 23, and 33 and their dependent claims.

In addition, the Kinanen reference is missing an axially stacked arrangement of rings as generally recited by independent claims 17, 20, 33, and 36. Specifically, independent claim 17 recites “the at least one main coil, the at least one bucking coil, and the at least one ring are positioned in a radially overlapping stacked relationship with one another.” Similarly, independent claim 20 recites “the means for generating, the means for shielding, and the means for intermediately shielding are positioned in an axially stacked relationship with one another.” Independent claim 33 recites “the opposite ferromagnetic rings are disposed axially between the opposite main coils and the opposite shielding coils, respectively.” Independent claim 36 recites “the MRI ferromagnetic ring is positioned axially between the MRI main coil and the MRI shielding coil in the axially stacked MRI arrangement.” Clearly, the Examiner has disregarded the normal meaning of terms such as axial, radial, stacked, and overlapping. One of ordinary skill in the art would not confuse the present claim language with the arrangements disclosed by the Kinanen reference, which does not teach or suggest any axially stacked (or radially overlapping stacked) relationship of at least three coils/rings. For at least this reason, among others, the Kinanen reference cannot support a *prima facie* case of anticipation of these claims.

For all of the above reasons, Appellants respectfully request that the Panel instruct the Examiner to withdraw the outstanding rejections and allow the pending claims.

Respectfully submitted,

Date: December 21, 2006


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